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EXAMINER

GOLOBOY, JAMES C

ART UNIT	PAPER NUMBER
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1714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/523,010	Applicant(s) REPO, HARRI	
	Examiner James Goloboy	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-37 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction-and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/30/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Use Claims

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 25-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 25-37 provide for the use of a composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 18 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

In order to overcome this rejection, it is advised that the applicant change "use" language in Claims 25-37 to "process of using", and add process steps.

Claim Objections

5. Claim 12 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 12 requires the lubricating oil of claim 11 to be "based on" turnip rapeseed oil or rapeseed oil. However, claim 11 already comprises turnip rapeseed oil or rapeseed oil "as a main component", which, in the examiner's opinion, is equivalent to "based on".

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 15, 25-28, and 35-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Regarding claim 15, the term "possibly" renders the claim indefinite because it is unclear whether the limitation(s) following the term are part of the claimed invention.

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See MPEP § 2173.05(d). The examiner recommends replacement of "possibly" with "optionally".

9. Regarding claims 25-28 and 35-37, the term "especially" renders the claim indefinite because it is unclear whether the limitation(s) following the term are part of the claimed invention. See MPEP § 2173.05(d). The examiner recommends that "especially in bakeries" be deleted from the claims.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 11-13, 15, 25, and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelm (U.S. Pat. No. 4,753,742) in view of Lawate (U.S. Pat. No. 5,538,654) and Anglin (U.S. PG Pub. No. 2002/0006519).

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In the abstract, Wilhelm discloses lubricating oils for the food industry, including bread dividers, comprising mineral oil, lecithin, and a vegetable oil. In column 6 (Examples X and XI), Wilhelm discloses specific compositions comprising these components. In column 5 lines 35-38 Wilhelm teaches that the mineral oil can be a pharmaceutical grade (U.S.P.) white oil, meeting the limitations of the auxiliary lubricant recited in claims 11-12 and 15 lecithin is an emulsifier recited in claim 1. Wilhelm's teaching that the lubricant is useful as a divider oil meets the limitations of claims 13 and 25. Wilhelm further discloses in column 7 lines 13-14 that the lubricants provide increased release characteristics, and in column 2 lines 7-12 teaches that this prevents food from sticking to pans, therefore rendering obvious the use of the lubricant as a pan oil, as in claims 13 and 35-36.

The differences between Wilhelm and the currently presented claims are:

i) Wilhelm discloses that the composition comprises a vegetable oil, but does not specifically disclose a rapeseed oil. This relates to claims 11-12.

ii) Wilhelm teaches in column 15-20 that the composition comprises an antioxidant, but does not disclose a synthetic tocopherol antioxidant. This relates to claims 11-12.

With respect to i), Lawate discloses in column 1 lines 7-10 a food grade lubricating oil. In column 4 lines 38-53 Lawate teaches that this oil comprises a vegetable oil as a main component. In column 7 lines 63-67, Lawate teaches that high oleic rapeseed oil, meeting the limitations of claim 11-12, is a preferred vegetable oil.

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With respect to ii), Anglin discloses in paragraph 12 a lubricant composition comprising a vegetable oil and a white mineral oil, which is usable in food-contacting products. In paragraph 21, Anglin teaches that the composition comprises an antioxidant, which can be tocopherol, meeting the limitations of claims 11-12.

It would have been obvious to one of ordinary skill in the art to use the rapeseed oil of Lawate as the vegetable oil of Wilhelm, as Lawate teaches that the oil is a preferred vegetable oil for a food grade lubricant. It would have been obvious to one of ordinary skill to use the antioxidant of Anglin, as Anglin teaches that it is effective for inhibiting oxidation in food-grade lubricant compositions comprising vegetable oil and white mineral oil.

13. Claims 14 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelm in view of Lawate and Anglin as applied to claims 11-13, 15, 25, and 35-36 above, and further in view of Buikstra (U.S. Pat. No. 5,650,190).

The discussion of Wilhelm in view of Lawate and Anglin in paragraph 12 above is incorporated here by reference. Wilhelm, Lawate, and Anglin disclose a composition comprising lecithin and meeting the limitations of claims 11 and 25, but not the specific use of hydrolyzed lecithin.

Buikstra, in column 1 lines 6-13, discloses an emulsion usable in food. In column 4 lines 49-52 Buikstra teaches that hydrolyzed lecithin, as recited in claims 14 and 26, is a suitable emulsifier for the emulsion.

It would have been obvious to one of ordinary skill in the art to use the hydrolyzed lecithin of Buikstra as the emulsifier in the composition of Wilhelm, Lawate, and Anglin, as Buikstra teaches in column 1 lines 61-65 that it leads to heat-stable emulsions.

14. Claims 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelm in view of Lawate and Anglin as applied to claims 11-13, 15, 25, and 35-36 above, and further in view of Kameoka (U.S. Pat. No. 5,166,375).

The discussion of Wilhelm in view of Lawate and Anglin in paragraph 12 above is incorporated here by reference. Wilhelm, Lawate, and Anglin disclose a lubricant composition meeting the limitations of claim 12. In column 4 lines 48-51 and 55-58, Wilhelm teaches that a lecithin concentration of 1%, falling within the ranges recited in claims 16 and 18, is sufficient to improve the lubricating and protective qualities of the oil. Wilhelm, Lawate, and Anglin do not disclose the concentrations of gamma- and delta-tocopherols within the antioxidant.

In column 3 lines 55-63, Kameoka describes a synergistic antioxidant composition comprising musizin and tocopherol in a ratio more preferably between 4.5:5.5 and 5.5:4.5. In column 4 lines 37-42, Kameoka teaches that the antioxidant is generally used in the range of 100 to 1000 ppm of the lubricant composition, translating to a concentration of 45 to 550 ppm of tocopherol. In column 6 lines 57-68 (Example 4), Kameoka teaches a suitable tocopherol, which combines 95% by weight gamma- and delta-tocopherol. The total concentration of gamma- and delta-tocopherol in the

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composition is therefore 42 to 523 ppm, or 0.0042 to 0.0523% by weight, encompassing the ranges of claims 16 and 18. The use of the tocopherol-containing antioxidant composition of Kameoka in the composition of Wilhelm, Lawate, and Anglin meets the limitations of claims 16 and 18.

It would have been obvious to one of ordinary skill in the art to use the antioxidant composition of Kameoka as the tocopherol antioxidant in the composition of Wilhelm, Lawate, Anglin, as Kameoka teaches that the components exhibit a synergistic effect.

15. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelm in view of Lawate, Anglin, and Buikstra as applied to claims 14 and 26 above, and further in view of Kameoka.

The discussions of Wilhelm in view of Lawate, Anglin, and Buikstra in paragraph 13 above and Wilhelm in view of Lawate, Anglin, and Kameoka in paragraph 14 above are incorporated here by reference. The use of the antioxidant composition of Kameoka as the tocopherol antioxidant in the composition of Wilhelm, Lawate, Anglin, and Buikstra meets the limitations of claim 17 and is obvious for the reasons discussed in paragraph 14 above.

16. Claims 19, 21, 27, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelm in view of Lawate and Anglin as applied to claims 11-13, 15, 25, and 35-36 above, and further in view of Nomura (U.S. Pat. No. 4,765,927).

The discussion of Wilhelm, Lawate, and Anglin in paragraph 12 above is incorporated here by reference. Wilhelm, Lawate, and Anglin disclose a lubricating composition in accordance with claims 11 and 15, but do not disclose the addition of citric acid to the composition.

In column 1 lines 30-45, Nomura describes that when a "well-known" antioxidant is used in combination with a condensed phosphate and citric acid, a synergistic effect is seen. Nomura additionally teaches that the antioxidizing composition is compatible with foods. In column 1 lines 57-58 Nomura teaches that the conventional antioxidant can be tocopherol, the antioxidant used in the composition of Wilhelm, Lawate, and Anglin. The use of the synergists of Nomura (condensed phosphate and citric acid) in the composition of Wilhelm, Lawate, and Anglin therefore meets the limitations of claims 19, 21, 27, and 37.

It would have been obvious to one of ordinary skill in the art to include the synergists of Nomura, including citric acid, in the composition of Wilhelm, Lawate, and Anglin, in order to greatly increase the activity of the antioxidant, as taught by Nomura.

17. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelm in view of Lawate, Anglin, and Buikstra as applied to claims 14 and 26 above, and further in view of Nomura.

The discussions of Wilhelm in view of Lawate, Anglin, and Buikstra in paragraph 13 above and Wilhelm in view of Lawate, Anglin, and Nomura in paragraph 16 above are incorporated here by reference. The addition of the synergists of Nomura to the

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composition of Wilhelm, Lawate, Anglin, and Buikstra meets the limitations of claim 20 and is obvious for the reasons discussed in paragraph 16 above.

18. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelm in view of Lawate, Anglin, and Kameoka as applied to claims 16 and 18 above, and further in view of Nomura.

The discussions of Wilhelm in view of Lawate, Anglin, and Kameoka in paragraph 14 above and Wilhelm in view of Lawate, Anglin, and Nomura in paragraph 16 above are incorporated here by reference. The addition of the synergists of Nomura to the composition of Wilhelm, Lawate, Anglin, and Kameoka meets the limitations of claim 22 and is obvious for the reasons discussed in paragraph 16 above.

19. Claims 23 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelm in view of Lawate, Anglin, Buikstra, and Kameoka as applied to claim 17 above, and further in view of Nomura.

The discussions of Wilhelm in view of Lawate, Anglin, Buikstra, and Kameoka in paragraph 15 above and Wilhelm in view of Lawate, Anglin, and Nomura in paragraph 16 above are incorporated here by reference. The addition of the synergists of Nomura to the composition of Wilhelm, Lawate, Anglin, Kameoka, and Buikstra meets the limitations of claim 23 and is obvious for the reasons discussed in paragraph 16 above. The combination of Wilhelm, Lawate, Anglin, Kameoka, and Buikstra additionally meets the limitations of claim 28.

20. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelm in view of Lawate and Anglin as applied to claim 11 above, and further in view of Mahler (U.S. Pat. No. 4,023,912).

The discussion of Wilhelm, Lawate, and Anglin in paragraph 12 above is incorporated here by reference. Wilhelm, Lawate, and Anglin disclose a composition containing lecithin and meeting the limitations of claim 11, but do not disclose the further addition of an aroma material to the composition.

In column 1 lines 11-21, Mahler discloses a cookware lubricant comprising lecithin. In column 7 lines 22-32 Mahler teaches that the composition can contain perfumes, meeting the "aroma material" limitation of claim 24, in order to mask the odor of lecithin.

It would have been obvious to one of ordinary skill in the art to include in the composition of Wilhelm, Lawate, and Anglin an odorant, as taught by Mahler, in order to mask the odor of lecithin, which Mahler teaches in column 1 lines 64-67 is undesirable.

21. Claims 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelm in view of Lawate and Anglin as applied to claims 11-13, 15, 25, and 35-36 above, and further in view of Marckx (U.S. Pat. No. 3,638,521).

The discussion of Wilhelm in view of Lawate and Anglin in paragraph 12 above is incorporated here by reference. Wilhelm, Lawate, and Anglin disclose a lubricating composition meeting the limitations of claim 11 and usable in food industry implements

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such as slicers, but do not disclose the spreading of the lubricant by means of mist lubrication.

Marckx, in the abstract, discloses a bread slicer. In paragraph 2 of the abstract, column 5 lines 5-60, and Fig. 4, Marckx discloses that a lubricating film can be applied by subjecting the blade of the slicer to a mist of an edible oil, such as the rapeseed oil-based composition of Wilhelm, Lawate, and Anglin.

It would have been obvious to one of ordinary skill in the art to apply the lubricating composition of Wilhelm, Lawate, and Anglin to a slicer by the mist process of Marckx, as Marckx teaches in column 5 lines 5-11 that it is particularly useful in processing bread products that are especially difficult to slice. Marckx additionally teaches that bread products at 54.4° C (130° F), within the range recited in claim 31, are among the breads that are difficult to slice, rendering claim 31 obvious as well.

22. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelm in view of Lawate, Anglin, Buikstra, and Nomura as applied to claim 20 above, and further in view of Marckx.

The discussions of Wilhelm, Lawate, Anglin, Buikstra, and Nomura in paragraph 17 above and Wilhelm, Lawate, Anglin, and Marckx in paragraph 21 above are incorporated here by reference. It would have been obvious to one of ordinary skill in the art to spread the lubricant of Wilhelm, Lawate, Anglin, Nomura, and Buikstra onto a bread slicer by the process taught by Marckx, for the reasons discussed in paragraph 20 above.

23. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelm in view of Lawate and Anglin as applied to claims 11-13, 15, 25, and 35-36 above, and further in view of Forsythe (U.S. Pat. No. 4,399,155).

The discussion of Wilhelm, Lawate, and Anglin in paragraph 12 above is incorporated here by reference. Wilhelm, Lawate, and Anglin disclose a lubricating composition meeting the limitations of claim 11 and which can be used for bread dividers and similar implements, such as slicers. Wilhelm, Lawate, and Anglin do not teach the temperature at which bread is sliced.

Forsythe, in column 16 lines 36-41, teaches that under commercial bakery conditions, bread is typically sliced at 100° to 110° F, which is 34.4° to 43.3°, overlapping the range recited in claim 31. Forsythe additionally provides an example where bread is sliced at 105° F (40.6° C), falling within the range recited in claim 31.

It would have been obvious to one of ordinary skill in the art to operate a bread slicer containing the lubricant of Wilhelm, Lawate, and Anglin at the temperatures taught by Forsythe, as Forsythe teaches that those are normal temperatures for slicing bread in a commercial bakery.

24. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelm in view of Lawate, Anglin, and Buikstra as applied to claims 14 and 26 above, and further in view of Forsythe.

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The discussions of Wilhelm in view of Lawate, Anglin, and Buikstra in paragraph 13 above and Wilhelm in view of Lawate, Anglin, and Forsythe in paragraph 23 above are incorporated here by reference. It would have been obvious to one of ordinary skill in the art to operate a bread slicer containing the lubricant of Wilhelm, Lawate, Anglin, and Buikstra at the temperatures taught by Forsythe, as Forsythe teaches that those are normal temperatures for slicing bread in a commercial bakery.

25. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelm in view of Lawate, Anglin, and Nomura as applied to claims 19, 21, 27, and 37 above, and further in view of Forsythe.

The discussions of Wilhelm in view of Lawate, Anglin, and Nomura in paragraph 16 above and Wilhelm in view of Lawate, Anglin, and Forsythe in paragraph 23 above are incorporated here by reference. It would have been obvious to one of ordinary skill in the art to operate a bread slicer containing the lubricant of Wilhelm, Lawate, Anglin, and Nomura at the temperatures taught by Forsythe, as Forsythe teaches that those are normal temperatures for slicing bread in a commercial bakery.

26. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelm in view of Lawate, Anglin, Buikstra, Kameoka, and Nomura as applied to claims 23 and 28 above, and further in view of Forsythe.

The discussions of Wilhelm in view of Lawate, Anglin, Buikstra, Kameoka and Nomura in paragraph 19 above and Wilhelm in view of Lawate, Anglin, and Forsythe in

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paragraph 23 above are incorporated here by reference. It would have been obvious to one of ordinary skill in the art to operate a bread slicer containing the lubricant of Wilhelm, Lawate, Anglin, Buikstra, Kameoka, and Nomura at the temperatures taught by Forsythe, as Forsythe teaches that those are normal temperatures for slicing bread in a commercial bakery.

Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Doumani (U.S. Pat. No. 4,073,412) discloses a cookware lubricant composition comprising mineral oil, vegetable oil, and lecithin.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is 571-272-2476. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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